

## REMARKS

This is a response to the final Office Action mailed May 3, 2006. Claims 1-9, 11-19, 25-29, 32, 33, and 36 are presently pending. Claims 1-9, 11-19, 25-30, 32, 33, and 35 are presently rejected. Claims 10 and 20-24, 31, and 34 have been previously cancelled and Claims 30 and 35 are cancelled by this response. New claim 36 is added by this response.

### Objection to the Specification

The disclosure was objected to for not properly identifying ALPHA PVC 319-40/45 as a trademark in the specification. The specification has been amended accordingly.

### Objection to the Claims

Claim 32 was objected to for not having the proper symbol and/or trademark designation. Claim 32 has been amended accordingly.

### Rejection Under 35 USC 102 over Langenbeck

Claims 1-9, 14, 19, 28-30 and 35 were rejected under 35 USC 102(b) as being anticipated by Langenbeck.

Regarding independent claim 1, the Examiner stated that Langenbeck teaches “wherein the earpiece is configured for use in either ear without modification” [emphasis added]. The Examiner then appears to extend this rejection to the method claims, stating that the method is inherent in that it simply provides logical implementation of the structure.

However, it is important to appreciate that the Langenbeck earpiece is not configured for use in either ear without re-configuration thereof. Please note that Applicant is drawing a distinction between modification and re-configuration.

**The conical piece of the Langenbeck earpiece must be turned with respect to the bow thereof in order to re-configure the Langenbeck earpiece from being**

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**suitable for use in one ear to being suitable for use in the other ear.** Although the Examiner may not consider this a modification of the Langenbeck earpiece, such turning is certainly a re-configuration of the earpiece since it results in a different shape thereof.

Langenbeck explicitly states “By holding the bow 6 and turning the conical piece 1 on the shaft 7 the holder may be brought from a position (Figs. 1 or 3) in which it fits the right ear into a position (Figs 2 or 4) in which it fits the left ear” [emphasis added] (page 2, column 1, lines 14-19). **Thus, the Langenbeck earpiece clearly requires re-configuration (turning the conical piece) in order to change its shape and thereby configure it for use in a particular ear.** If the Langenbeck earpiece had not been configured for use it a particular ear, then it would not have the proper shape and therefore would not fit in that ear.

As the Examiner stated in the Office Action, Applicant’s earpiece is rotated for the purpose of moving the device from one ear to the next. This rotation is a change in the orientation of the earpiece. It does not involve changing the configuration thereof. That is, the shape of the earpiece itself doe not change. It is merely flipped upside down. Indeed, the earpiece of the present invention has no parts that move with respect to one another (as does the Langenbeck earpiece), and therefore is not even reconfigurable.

By way of contrast, the Langenbeck earpiece must actually change the shape or configuration thereof in order to be used in a different ear. The ability of the present invention to be used in either ear is due, at least in part, to the symmetric configuration thereof.

Independent claims 1, 25, 28, and 29 have been amended and new independent claim 36 has been added to substantially recite the limitation that the earpiece of the present invention is configured for use in either ear by “re-orienting the earpiece without re-configuring the earpiece.”

It is respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious, “wherein the earpiece

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is configured for use in either ear by re-orienting the earpiece without re-configuring the earpiece,” as substantially recited in amended independent claims 1, 25, 28, 29 and 36.

### **Rejection Under 35 USC 102 over Baskerville**

Claims 1-7, 11-15, 25-26, and 28-30 were rejected under 35 USC 102(e) as being anticipated by Baskerville.

Regarding claims 1-3, the Examiner stated that “Baskerville teaches a device (10) for facilitating hearing . . . wherein the earpiece is configured for use in either ear without modification of the earpiece by virtue of its construction being substantially similar to the present invention.”

However, Applicant respectfully submits that the Baskerville earpiece is not substantially similar to the present invention and cannot be used in either ear. The Baskerville earpiece is very asymmetric (see Figures 1 and 2) and the present invention is symmetric. The Baskerville earpiece has one lobe thereof being much larger than the other lobe thereof (as best seen in Figure 2). By way of contrast, the present invention has both lobes thereof the same size (it is symmetric). This distinction can be readily seen in Exhibit 1, as discussed below.

Thus, a given Baskerville earpiece is specifically configured for used in one ear (either the left or the right ear). The non-symmetric configuration of the Baskerville earpiece prevents the use of an earpiece configured for use in the right ear from being used in the left ear, and vice-versa.

More particularly, the longer upper lobe (see Figure 1) of the Baskerville earpiece is configured to be received within the cyma conchae (the groove above the ear canal) of the particular ear (right or left) for which the earpiece is configured. The earpiece of Figure 1 is configured for use in the right ear. That is, the longer lobe is on top and is thus positioned so as to be received within the cyma conchae.

If the earpiece is removed from its intended ear, it can be flipped over in order for the boss 26 thereof to be oriented such that it will be inserted into the ear canal of the

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other ear. If the earpiece is not flipped over, the boss 26 will extend outwardly, away from the ear canal in a manner that renders the earpiece useless. However, flipping the Baskerville earpiece over to move it from one ear to another, places the large lobe that was on the top in Figure 1 (such that the earpiece was properly oriented for use in the right ear) on the bottom. When the larger lobe is on the bottom, it cannot be received by the cyma conchae and thus the earpiece of Figure 1 will not fit properly within the left ear.

Baskerville does not teach that the earpiece disclosed therein is configured such that a given earpiece can be used in either ear. To the contrary, Baskerville states that the earpiece includes an outer portion that is “complimentary in shape to the outer ear of the individual.” As those skilled in the art will appreciate, an earpiece that is complimentary in shape to the outer ear of the right ear is not complimentary in shape to the outer ear of the left ear, and visa-versa, since the shape of the outer ear of the right ear is substantially a mirror image of the left ear. Indeed, a Baskerville earpiece intended for the right ear will be a mirror image of a Baskerville earpiece intended for the left ear and visa-versa.

A picture of right and left earpieces of the general type disclosed by Baskerville is attached hereto as Exhibit 1. Exhibit 1 clearly shows that the right and left earpieces are mirror images of one another. That is, each earpiece is configured for use in a particular (right or left) ear.

Further evidence that earpieces of the general type disclosed by Baskerville are specifically configured for use in either the right or left ear is provided in Exhibit 2. Exhibit 2 is taken from a web page for Otto Engineering at the Internet address:

[http://www.ottoeng.com/cgi-bin/comm\\_search.pl?mode=Search%20by%20Category&categoryid=42](http://www.ottoeng.com/cgi-bin/comm_search.pl?mode=Search%20by%20Category&categoryid=42)

Exhibit 2 clearly shows that Otto Engineering sells both left and right earpieces (designated as “Flexible Open Ear Inserts” by Otto Engineering). Thus, Otto Engineering apparently considers a given earpiece of this type to be configured for use in only one ear

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(left or right). The earpiece of Exhibit 2 is of the same general type as the Baskerville earpiece.

Applicant respectfully submits that the earpiece disclosed by Baskerville is not configured for use in either ear without modification by virtue of its construction being substantially similar to the present invention. Rather, the earpiece disclosed by Baskerville and similar earpieces (such as that disclosed in Exhibit 2) are simply not similar enough in construction to the claimed earpiece to be configured for used in either ear.

A distinction should be made between something being configured for a particular use and the ability to abuse the item and use it in a manner for which it is not configured. While it may be possible to insert a Baskerville earpiece made for the left ear into right ear and visa versa, such use will result in problems because the left earpiece is not configured for use in the right ear. Use of a left Baskerville earpiece in the right ear can result in discomfort, pain, and tissue damage as portions thereof (such as the larger upper lobe that is intended to be disposed within the cymba conchae) rub against portions of the conchae bowl. Also, using such an earpiece in the wrong ear can result in improper positioning of the boss (the portion that extends into the ear canal) such that the boss undesirably contacts the ear canal with similar undesirable results.

**For example, shoes are configured for use with a particular foot (right or left). The fact that a shoe can be worn on the wrong foot is not an indication that the shoe is configured to be worn on either foot.**

Further, in the rejection of claims 32-33 the Examiner stated that Applicant does not provide a standard for ascertaining the requisite degree of symmetry. Applicant has amended claim 32 to provide such a standard. More particularly, independent claim 32 has been amended to recite “wherein the earpiece is sufficiently symmetrical to be configured for use in either the right or left ear.” The Baskerville earpiece does not conform to this standard and thus does not meet the claim limitation.

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In the rejection of claims 25-27 under 35 USC 103(a) as being unpatentable over Langenbeck, the Examiner stated that Langenbeck teaches all of the limitations in claims 25-27. However, as discussed above, it is respectfully submitted that Langenbeck fails to teach “wherein the earpiece is configured for use in either ear by re-orienting the earpiece without re-configuring the earpiece,” as recited in amended independent claim 25.

### **Rejections Under 35 USC 103**

Claims 16-18 were rejected under 35 USC 103(a) as being unpatentable over Langenbeck or Baskerville. Claims 16-18 depend from independent claim 1, which, as amended, is believed to be allowable.

Claims 27 and 32-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Baskerville. Claim 27 depends from independent claim 25, which, as amended, is believed to be allowable. Claim 32 has been amended to recite “wherein the earpiece is sufficiently symmetrical to be configured for use in either the right or left ear” and is thus believed to be allowable. Claim 33 depends from claim 32 and is thus believed to be allowable.

Claims 25-27 and 32-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Langenbeck. Claim 27 depends from independent claim 25, which, as amended, is believed to be allowable. Claim 32 has been amended to recite “wherein the earpiece is sufficiently symmetrical to be configured for use in either the right or left ear” and is thus believed to be allowable. Claim 33 depends from claim 32 and is thus believed to be allowable.

### **Admitted Prior Art**

The Examiner stated that since Applicant did not traverse the Examiner’s assertion of official notice with respect to claims 16-18, 25-27, and 32-33 that the common knowledge or well-known in the art statement is taken to be admitted prior art. However, Applicant does not agree that all of the contents of claims 16-18, 25-27, and 32-33 are necessarily common knowledge or well-known and therefor are prior art. Indeed, Applicant believes that dependent claims are independently patentable with

respect to the independent claims. For example, Applicant does not believe that any of the cited references either disclose or make obvious that "the earpiece is generally symmetric about a plane that bisects the earpiece," as recited in dependent claim 6.

### CONCLUSION

It is therefore respectfully submitted that all of the claims of the subject patent application are in condition for immediate allowance. Reconsideration and an early allowance are therefore requested.

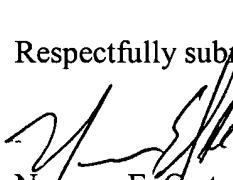
If the Examiner has any questions or concerns, a telephone call to the undersigned at (949) 752-7040 is welcomed and encouraged.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:  
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Monique M. Butler

September 5, 2006  
Date of Signature

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